

## **REMARKS**

Claims 80-90 are currently pending in this application and stand rejected from the Final Office Action dated March 22, 2006. As described below, Applicants have amended herein claims 80, 84, and 90. Applicants present those amendments and the following comments in support of the patentability of the pending claims.

### **I. Applicants' Summary of Interview**

Applicants greatly appreciate the Office's time and participation for the interview on July 11, 2006, with the undersigned and co-inventor Chet Gooding. Pursuant to MPEP § 713.04, Applicants provide the following substance of that interview.

As reflected in the Office's Interview Summary, Applicants discussed the term "at least about" as that term appears in claims 80 and 84. Applicants stated their belief that this term is not indefinite, as it would be readily understood by the skilled artisan in light of the present specification. The Examiner inquired about examples for what a "longitudinal dimension at least about two times the transverse dimension" may cover; Applicants stated that one example of what this term may cover is variances in the papermaking and converting processes, such as manufacturing tolerances.

Applicants also discussed the relationship between a longitudinal dimension and a web's machine direction, and between a transverse dimension and a web's cross-machine direction, noting that none of the cited references taught or suggested any longitudinal folding in the machine direction. The Office appeared to agree that none of the references of record taught at least one transverse fold in the machine direction with no longitudinal folds in the cross-machine direction.

The Examiner also discussed a possible amendment directed to the orientation of the paper web, to further clarify that the at least one transverse fold recited in the pending claims is in the cross-machine direction. Applicants stated that such an amendment was not necessary but, in an effort to further the prosecution of this application, have amended the claims herein to recite “optionally orienting the web for transverse folding in the machine direction,” merely to further indicate that that which was already present in the claims.

Once again, Applicants appreciate the Office’s personal interview with the undersigned and Mr. Gooding. If the undersigned has misunderstood any part of the interview as reflected in the above statement of its substance, Applicants respectfully request that the Examiner please contact the undersigned to discuss an appropriate resolution.

## **II. Claim Amendments**

Applicants have amended claims 80 and 84 to recite “a longitudinal dimension in the machine direction” and “a transverse dimension in the cross-machine direction,” which are fully supported in the original specification by at least the paragraph bridging pages 27 and 28. Applicants have also amended claims 80 and 84 to recite “wherein the longitudinal dimension is at least about two times the transverse dimension,” which is fully supported in the original specification by at least the first full paragraph on page 12. As described above, Applicants have amended claims 80 and 84 to recite “optionally orienting the web for longitudinal folding in the machine direction,” which is fully supported in the specification by at least the paragraph bridging pages 32 and 33.

Finally, Applicants have amended claims 80 and 84 to recite “wherein the longitudinal dimension is at least about two times the transverse dimension,” which is fully supported in the specification by at least the full paragraph on page 27.

With at least the above-mentioned specification support, Applicants submit that the amendments to claims 80, 84, and 90 do not add any new matter and that the skilled artisan would readily understand Applicants to have been in possession of the claimed subject matter at the time this application was filed. Therefore, Applicants request that the Office enter the amendments to those claims without objection.

### **III. Rejection under 35 U.S.C. § 112, Second Paragraph**

The Office rejected claims 80-90 under 35 U.S.C. § 112, second paragraph, as indefinite for not particularly pointing out and distinctly claiming the subject matter that Applicants regard as the invention. In particular, the Office believes that the recitation of “at least about” is indefinite because the specification discloses wide ranges for the length and width of the paper web and a specific determination cannot be made of what Applicants intend to claim by reciting “at least about 2 to 1.” See Office Action at 2.

As stated in the Reply to Office Action dated October 6, 2005, Applicants believe that the scope of “about” as used in pending claims is not indefinite, but rather would be clear to one of ordinary skill in the art. See, e.g., MPEP § 2173.05(b) (citing *Ex Parte Eastwood*, 163 U.S.P.Q. 316 (B.P.A.I. 1968) (“[T]he term [about] is clear but flexible and is deemed to be similar in meaning to terms such as ‘approximately’ or ‘nearly’.”)). Simply because the term “about” is used in reference to a ratio does not make the term indefinite. The specification and claims clearly reveal to the skilled artisan that this term

indicates that the ratio of the longitudinal dimension to the transverse dimension is at least about 2. However, merely in an effort to advance the prosecution of this case toward allowance, and without any surrender of claim scope, Applicants have amended claims 80 and 84 to clarify their use of “at least about” by reciting “wherein the longitudinal dimension is at least about two times the transverse dimension.” In addition, further to the Examiner’s request during the interview on July 11, 2006, Applicants have noted that one example of what this term may cover is variances in the papermaking and converting processes, such as manufacturing tolerances.

In light of the above arguments, Applicants assert that the recitation of “at least about” would be clear and readily understood by one of ordinary skill in the art. Therefore, Applicants respectfully request that the rejection be withdrawn.

#### **IV. Rejections under 35 U.S.C. § 102(b)**

##### **Lazar**

The Office has rejected claims 80-81, 84, 86, and 90 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 1,256,334 to Lazar (“Lazar”). In particular, the Office believes that Lazar discloses a method of making a paper napkin comprising providing a first transverse fold by folding one free edge towards the other free edge to create two panels, and further folding the first transverse fold towards the free edge to create a second transverse fold and thus a four paneled web. See Office Action at 3. Applicants respectfully traverse this rejection.

As noted in the Interview Summary above, the Office has apparently agreed that Lazar does not teach or suggest any folds in the machine direction. In contrast, the

process of Lazar, as described in particular on page 1, line 104 through page 2, line 2, would clearly indicate to the skilled artisan that its folds are in the cross-machine direction. As noted on page 11 of the Reply to Office Action dated October 6, 2005, longitudinal folding results in transverse folds, while transverse folding results in longitudinal folds. The pending claims recite at least one transverse fold, which is in the machine direction, and no longitudinal folds as in Lazar, which would be in the cross-machine direction. Therefore, Lazar does not teach or suggest each and every limitation of the instant claims and Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be withdrawn.

**Chan**

The Office rejected claims 84-85 and 88 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,716,691 to Chan ("Chan"). In particular, the Office believes that Chan discloses a method of folding a web by folding a transverse free edge towards the other free edge, creating a fold line, and subsequently folding the fold line toward the transverse free edge, creating another fold line and three panels. See Office Action at 3. Applicants respectfully traverse this rejection.

As with Lazar, Chan fails to teach or suggest that its folds are transverse folds in the machine direction with no longitudinal folds. In fact, the particular folding structure of Chan suggests that at least one fold must be in the cross-machine direction, due to the overall folding structure taught by the reference, thereby resulting in a longitudinal fold. Therefore, Chan fails to teach each and every limitation of the instant claims and Applicants respectfully request that this rejection be withdrawn.

**V. Rejections under 35 U.S.C. § 103(a)**

**Lazar in view of the Supposed Admitted Prior Art**

The Office rejected claims 82-83 and 87 under 35 U.S.C. § 103(a) as obvious over Lazar in view of Applicants' supposed Admitted Prior Art ("APA"). In particular, the Office believes that, although Lazar does not directly disclose either the dimensions or the basis weights of its products, that it would have been obvious to one of ordinary skill in the art to apply the folding method of Lazar to paper webs that achieve the recitations of claims 82-83 and 87. See Office Action at 3. The Office further states that "the previously made common knowledge modification is taken to be prior art because applicant failed to traverse the examiner's assertion of official notice." Office Action at 3-4. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must have been a reasonable expectation of success to make that modification or combination. Finally, the prior art reference(s) must teach or suggest all the claim limitations. See MPEP § 2143. The references cited in the Office Action fail to meet any of these requirements.

Although Applicants disagree with the Office and believe that a proper traverse of the Official Notice was provided in the Reply to Office Action dated October 6, 2005, on at least pages 10-11, Applicants assert that the rejection is now moot in light of the Examiner's Interview and the discussion above as to Lazar failing to teach or suggest any method of making a paper product with at least one transverse fold and no

longitudinal fold. Because Lazar fails to teach or suggest at least that claim element, and the supposed APA neither remedies that deficiency nor provides any suggestion or motivation to achieve the subject matter of the pending claims, a *prima facie* case of obviousness has not been established. Therefore, Applicants respectfully request that the rejection be withdrawn.

**Ito**

The Office rejected claims 84-85 and 88-89 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,469,243 to Ito et al. ("Ito"). In particular, the Office states that "Ito describes forming transverse folds in a web in order to produce wipes. The invention contemplates multiple fold configurations as well as materials." Office Action at 4. Applicants respectfully traverse this rejection.

Ito does not teach or suggest the method of the pending claims. As is clear from its specification, and in particular Figure 1, the process disclosed in Ito operates on continuous rolls of paper. Ito does not teach or suggest a paper web having at least the dimensions and structure recited in the pending claims. Therefore, the reference fails to teach or suggest each and every limitation of the instant claims and cannot properly form the basis of a *prima facie* case of obviousness. Applicants respectfully request that this rejection be withdrawn.

**VI. Conclusion**

Applicants submit, and the Office has apparently agreed in the Examiner's Interview, that none of the references of record either teach or suggest the methods recited by the pending claims of this application. As such, those references, whether

taken alone or in any combination, fail to either anticipate or render obvious the pending claims. Therefore, Applicants respectfully request that the rejections be withdrawn and the claims passed to allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 14, 2006

By: 

Robert C. Stanley  
Reg. No. 55,830